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| 09/587,092 | 05/31/2000 | Steven R. Hoffman | VISAP026 | 6899 |
| 22434 | 7590 | 12/01/2005 | EXAMINER | |
| BEYER WEAVER & THOMAS LLP | | | BORLINGHAUS, JASON M | |
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| OAKLAND, CA 94612-0250 | | | PAPER NUMBER | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/587,092

Applicant(s)

HOFFMAN ET AL.

Examiner

Jason M. Borlinghaus

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/15/03 has been entered.

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Specification

Applied Cryptography et al., which is incorporated by reference on pp.8 - 9, is presumed to be "essential material" because it is referred to in the Detailed Description section of the specification (p.8, line 20 - p. 9, line 10).

The incorporation of essential material in the specification by reference to an unpublished U.S. application, foreign application or patent, or to a publication

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is improper. Applicant is required to amend the disclosure to include the material incorporated by reference, if the material is relied upon to overcome any objection, rejection, or other requirement imposed by the Office. The amendment must be accompanied by a statement executed by the applicant, or a practitioner representing the applicant, stating that the material being inserted is the material previously incorporated by reference and that the amendment contains no new matter. 37 CFR 1.57(f).

Applicant may propose to amend the specification to remove the incorporation by reference. Such an amendment will be entered only if, first, applicant submits a copy of the subject reference with a proper information disclosure statement, as disclosed above, and, second, examiner judges that the subject reference is not essential material.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.

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2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1 – 2 and 4 – 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rankl (Rankl, W. & Effing, W. *Smartcard Handbook*. John Wiley & Sons. West Sussex, England. 1997. pp. 21 – 23, 336 – 337, 343 – 345 and 363 - 364).

Regarding Claims 1 – 2, Rankl discloses a smart card loading system for loading value over a telecommunications network onto a smart card (Mondex purse) said smart card loading system (“This technique naturally allows the loading of the purse over the phone, or a transaction between two cardholders.” – see p. 344) comprising:

- a smart card (Mondex purse – see pp. 343 - 344);
- a telephone handset (telephone with a built-in card reader) in communication with said telecommunications network. (“It allows money to be transferred over the line during the call.” – see p. 344 – establishing that the handset is in communication with said telecommunications network);
- a smart card reader (telephone with a built-in card reader) for communicating with a said smart card when said smart is inserted in said handset. (see p. 344); and
- an input interface (see wallet, figure 12.16, p. 344) for indicating a value to be loaded onto said smart card (It would be inherent that

an input interface exists to indicate a value to be loaded onto said smart card as the need for such an input interface was recognized for the related smart card loading system, the Mondex wallet. –

“The amount to be transferred is input...” – see p. 344);

- said handset being arranged to generate a message request to load (credit) said value (sum) onto said smart card. (“value transfer” phase requesting sum – see p. 346) and to load (credit) said value (sum) onto said smart card (“The amount is now credited.” – see p. 346. “When loading the card from a bank account...” – see p. 344);
- a fund issuer computer arranged to receive said request message and to debit a consumer account with said smart card. (“When loading the card from a bank account...” – see p. 344); and
- whereby said smart card may be authorized to load said value via said telephone handset. (supra, see p. 344).

Rankl also discloses a smart card loading system for loading value over a network onto a smart card (inter-sector electronic purse) said smart card loading system comprising (see pp. 336 – 337):

- a smart card (inter-sector electronic purse – see p. 336);
- a fund issuer computer (PPSAM) arranged to receive said request message (first purse instruction). (see p. 337);
- an authentication computer (PPSAM) arranged to receive said request message and to authenticate said smart card (authenticate signature S_1 – see p. 337);

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- whereby said smart card may be authorized to load said value via said terminal. ("Again, this only relays the data to the card, this time with the instruction CREDIT IEP." – see p. 337).

Rankl also discloses a system (GSM Network) comprising:

- a mobile telephone handset (see mobile equipment, figure 13.2, p. 363) in communication with said telecommunications network;
- said handset including a subscriber identification module (see SIM, figure 13.2, p. 363) that is separate from said smart card and functions to allow a user to access telecommunications network. ("The SIM's task is to permit network access only to authorized persons..." – see p. 364);
- a gateway computer (mobile services switching center – see p. 363) arranged to receive said message from said handset over said telecommunications network and retransmit (forwarding) said message; and
- wherein said telecommunications network is a wireless network (see common air interface, see figure 13.2, p. 363).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the telephone smart-card loading system (Mondex system), as disclosed by Rankl, by incorporating the standard computer network and protocols for smart-card transactions, as disclosed by Rankl, to allow the telephone smart-card loading system to take advantage of the benefits of the standard computer system for such transactions.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have further modified the telephone smart-card loading system, as disclosed by Rankl, by incorporating wireless technology (GSM network) and technology for utilization of such technology (mobile services switching center), as disclosed by Rankl, to allow the telephone smart-card loading system to function anywhere that wireless communication is possible.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have further modified the telephone smart-card loading system, as disclosed by Rankl, by incorporating SIMs, as disclosed by Rankl, as SIM can be utilized to provide further data storage and security functions for the transaction.

Regarding Claim 4, Rankl discloses a smart card loading system wherein:

- said authentication computer (PPSAM) authenticates said smart card (inter-sector electronic purse) using a first cryptographic signature (signature S_1) and generates a second cryptographic signature (signature S_2) to authenticate a load response (CREDIT IEP), whereby said transaction is secure. (see p. 337).

Regarding Claim 5, Claim 5 recites similar limitations to Claims 1 and 4, in combination, and is therefore rejected using the same art and rationale as applied in the rejection of Claims 1 and 4, in combination. Claim 5 differs from Claims 1 and 4 in that Claim 5 is for a smart card loading system further comprising:

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- the smart card is able to be removed from the handset to interface with a point-of-sale terminal through a contact interface with the point-of-sale terminal.

Rankl discloses a smart-card loading system further comprising:

- the smart card is able to be removed from the telephone handset to interface with a point-of sale terminal (trader terminal) (pp. 344 – 345); and
- the smart card is able to interface with a point-of sale terminal through a contact interface with the point-of-sale terminal. (pp. 21 – 23).

Regarding Claim 6, Claim 6 recites similar limitations to Claim 2 and is therefore rejected using the same art and rationale as applied in the rejection of Claim 6.

Regarding Claim 7, Rankl does not teach a smart-card loading system wherein:

Said funds request message is integrated with the Short Message Service channel of said telecommunications network.

Utilization of the Short Message Service channel for transmission of data or messages is old and well known in the art of telecommunications and mobile system design. It would have been obvious to one with ordinary skill in the art at the time the invention was made to have modified Rankl by incorporating the ability to transmit the request message, as previously disclosed by Rankl, via the

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Short Message Service channel, as is old and well-known in the art, to utilize a standard telecommunications standard for transmission of data.

Regarding Claim 8, Rankl discloses a smart-card loading system:

- wherein in response to a successful load (confirm successful updating), said handset (terminal) is arranged to generate a transaction certificate (signature S_3) to be used for irrepudiation.

(see p. 337).

Regarding Claim 9, Claim 9 recites similar limitations to Claims 1, 4 and 5, in combination, and is therefore rejected using the same art and rationale as applied in the rejection of Claims 1, 4 and 5, in combination.

Regarding Claim 10, Claim 10 recites similar limitations to Claim 2 and is therefore rejected using the same art and rationale as applied in the rejection of Claim 2.

Regarding Claim 11, Claim 11 recites similar limitations to Claim 7 and is therefore rejected using the same art and rationale as applied in the rejection of Claim 7.

Regarding Claim 12, Claim 12 recites similar limitations to Claims 1, 4 and 5, in combination, and is therefore rejected using the same art and rationale as applied in the rejection of Claims 1, 4 and 5, in combination.

Regarding Claim 13, Claim 13 recites similar limitations to Claim 2 and is therefore rejected using the same art and rationale as applied in the rejection of Claim 2.

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Regarding Claim 14, Claim 14 recites similar limitations to Claim 7 and is therefore rejected using the same art and rationale as applied in the rejection of Claim 7.

Regarding Claim 15, Claim 15 recites similar limitations to Claim 8 and is therefore rejected using the same art and rationale as applied in the rejection of Claim 8.

Response to Arguments

Applicant's arguments with respect to pending claims have been considered but are moot in view of the new ground(s) of rejection.

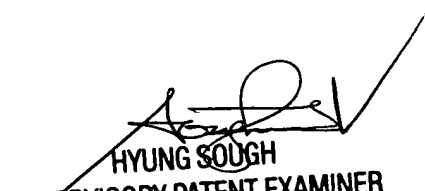
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Borlinghaus whose telephone number is (571) 272-6924. The examiner can normally be reached on 8:30am-5:00pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung Sough can be reached on (571) 272-6799. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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